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PATENT APPLICATIONHEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400ATTORNEY DOCKET NO. 200209473-1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Andersen et al.

Confirmation No.: 5231

Application No.: 10/627,560

Examiner: Thomas A. Morrison

Filing Date: 07/25/03

Group Art Unit: 3653

Title: SYSTEM AND METHOD FOR HANDLING PRINT MEDIA

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 10/17/06.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:☐ 1st Month
\$120☐ 2nd Month
\$450☐ 3rd Month
\$1020☐ 4th Month
\$1590☐ The extension fee has already been filed in this application.☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.☒ A duplicate copy of this transmittal letter is enclosed.☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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Typed Name: Doreen Zabinski

Signature: Doreen Zabinski

Respectfully submitted,

Andersen et al.

By Petar Kraguljec

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|------------------------------|---|------------------------------|
| In re application of: |) | Examiner: Thomas A. Morrison |
| Andersen et al. |) | |
| |) | Art Unit: 3653 |
| Serial No.: 10/627,560 |) | |
| |) | |
| Filed: July 25, 2003 |) | |
| |) | |
| For: SYSTEM AND METHOD FOR |) | |
| HANDLING PRINT MEDIA |) | |
| |) | |
| Date of Final Office Action: |) | Attorney Docket No.: |
| July 19, 2006 |) | 200209473-1 |
| |) | |
| Notice of Appeal Filed: |) | |
| October 17, 2006 |) | |

December 11, 2006

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:


This Appeal Brief is timely provided to support the Notice of Appeal filed October 17, 2006.

CERTIFICATE OF FACSIMILE

Date of Deposit: December 11, 2006

12/12/2006 TBESHAH1 00000072 002025 10627560

I hereby certify that these papers are being transmitted to The United States Patent and Trademark Office
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Doreen Zabinski

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1. Real Party in Interest:

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, USA.

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2. Related Appeals and Interferences

There are no other prior and/or pending appeals, interferences, or judicial proceedings that are related to, directly affect, or that will be directly affected by or have a bearing on the Board's decision.

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3. Status of Claims

Claims 1-21 are pending in the application.

Claims 1-21 stand rejected in the application.

Claims 22-31 were canceled in the application.

The rejections of claims 1-21 are appealed.

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4. Status of Amendments

No Amendments were filed subsequent to the Final Office Action.

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5. Summary of Claimed Subject Matter

As stated in the paragraph [0001] of the specification, some image forming devices can have large footprints and take up large areas of floor space. The specification describes a system that can help reduce the foot print of image forming devices by configuring a duplex media path to receive input paper from a media feeder (see specification paragraph [0014]) thereby allowing different positioning of the media feeder and a high capacity paper storage unit. The particular claimed subject matter will now be discussed with reference to independent claims 1, 10 and 16.

Independent Claim 1

Claim 1 is directed to a media handling system for an image forming device configured with a primary media path and a duplex media path (see for example, Figure 2, primary media path 210 and duplex/return media path 230, paragraphs [0021-0023]). Claim 1 recites a media feeder positioned adjacent to one side of the image forming device and configured to input print media into the duplex media path of the image forming device, and the media feeder being positioned to not be part of the duplex media path. See for example Figure 2 that shows media feeder 225 positioned adjacent the image forming device 200 and can input print media into the return media path 230. See also paragraph [0022]. As shown in Figure 2, since the media feeder 225 is separated from the return media path 230, it is positioned to not be part of the path.

Independent Claim 10

Claim 10 is directed to a media handling apparatus for inputting non-imaged media into an image forming device having a primary media path along which an image is formed on a print media (see Figure 2, image forming device 200 having a primary media path 210). The claim recites a return media path configured to selectively receive imaged print media from the primary media path and return the imaged media to the primary media path for multiple imaging (Figure 2, return media path 230). A media input unit is configured for

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attachment to one side of the image forming device to input non-imaged media into the return media path of the image forming device, where the media input unit is positioned where the return media path does not return the imaged media across the media input unit during duplex printing. With continued reference to Figure 2 and paragraph [0022], media feeder 225, media storage unit 235, and its configuration with the return media path 230 discloses an example. The claim further recites a media output unit for receiving imaged media discharged from the primary media path, the media output unit being configured for attachment to the one side of the image forming device and stacked above the media input unit (see Figure 2, output device 240 stacked above media feeder 225 and media storage unit 235).

Independent Claim 16

Claim 16 is directed to an image forming apparatus (device 100 in Figure 1, device 200 in Figure 2, or device 300 in Figure 3, for example). The apparatus comprises a housing having at least one wall, an image forming unit (e.g. elements 130 or 215) provided within the housing for forming an image onto print media, and a media storage unit configured to store a supply of non-imaged print media (e.g. media storage unit 235 in Figure 2).

Claim 16 further recites a primary media path for carrying print media to the image forming unit for imaging (e.g. primary media path 210 in Figure 2) and a duplex media path (e.g. return media path 230) configured to receive imaged print media from the primary media path and return the imaged print media to the primary media path for duplex imaging where the returned imaged media is not returned to the media storage unit during the duplex imaging (see Figure 2 and configuration of these elements). The duplex media path is configured to receive non-imaged print media from the media storage unit and to input the non-imaged print media to the primary media path for imaging. See paragraphs [0022-0023] and Figure 2 where return media path 230 is configured to receive non-imaged print media from the media feeder 225.

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Dependent Claim 21

Claim 21 depends from independent claim 16 and recites logic to determine whether print media is inputted into the primary media path or the duplex media path (see paragraph [0017] and Figure 1, controller 105 or logic 115).

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6. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are to be reviewed on appeal:

I. Whether Claims 1-8, 10-12 and 14-19 are unpatentable under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,042,791 (Stemmle).

II. Whether Claim 21 is unpatentable under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,042,791 (Stemmle) or in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5,042,791 (Stemmle) in view of U.S. Patent No. 5,724,642 (Cala).

III. Whether Claims 9, 13 and 20 are unpatentable under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,042,791 (Stemmle) as applied to claims 6, 10 and 16, and further in view of U.S. Patent No. 6,308,948 (Azumi).

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7. Argument

I. Whether Claims 1-8, 10-12 and 14-19 are unpatentable under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,042,791 (Stemmle).

Independent Claim 1

The issue here can be resolved by answering one question: Does Figure 8 of Stemmle teach that the paper tray 83 inputs print media into a duplex media path of the duplex path side shifting inverter 40 or not. Appellant respectfully submits that paper tray 83 does not input paper into the duplex path but rather inputs paper at a point outside the duplex path. As will be described, the input point (at rollers 88) is outside the duplex path of inverter 40. Therefore, Stemmle fails to teach the limitations of claim 1 and fails to support a proper §102 rejection.

Claim 1 recites a media feeder ... configured to input print media into the duplex media path of the image forming device. With reference to figures 1 and 8 in Stemmle, the Final Office Action on page 2 identifies a duplex media path in Stemmle as from rollers 39 to 42, then the paper passes through inverter 40 and the paper is outputted into rollers 88. The rejection relies on figure 8 (where a paper tray 83 inputs paper into rollers 88) to teach the limitation of "to input print media into the duplex media path". Appellant notes that rollers 88 are labeled in figure 1, but are not labeled in figure 8. Figure 8 has been reproduced below with a reference to identify rollers 88, which are identified by Stemmle as "transport rolls 88" (Stemmle, column 9, lines 38-39).

Appellant respectfully submits that Stemmle fails to teach or suggest the claimed media feeder and claimed configuration with the duplex media path. Stemmle teaches that the duplex path is formed by a "duplex path side shifting inverter 40" (Stemmle, column 6, lines 46-62). When the paper is inverted by the inverter 40, the paper exits the inverter 40

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and thus exists the duplex path. The paper then proceeds to the transport rolls 88 for further processing.

From reading Stemmler, one of ordinary skill in the art would understand that the rolls 88 are outside the duplex path. Stemmler confirms this interpretation. For example, Stemmler describes the "print substrate path" of the duplex inverter 40 starting at column 6, line 63 to column 7, line 27. The path of the inverter 40 is described with reference to Figs. 3A, 3B, 4A, 4B, 5A, 5B, 5C and 6 (column 6, line 64).

Appellant first notes that rolls 88 are not shown as part of the inverter 40 in any of these figures. Secondly, Stemmler explicitly differentiates between the inverter path and the next processing section. In particular, once the inverter 40 is finished with the paper, the paper is outputted to a "processor portion" of the printing machine. With reference to Figure 5C, Stemmler states:

"There are two pairs of rightward driving nip rolls 63, 64, 65 and 66 which drive the print substrate out of the inverter back to the processor portion of the printing machine to complete the duplex print." (Stemmler, column 7, lines 23-27) [emphasis added]

Figure 5C shows the paper 31 exiting the duplex path of the inverter 40 via the rolls 65 and 66. With reference to Figure 1, the next portion after the inverter 40 (i.e., the processor portion) begins with the transport rolls 88 and leads to the transfer station 29 for imaging to complete the duplex print. Accordingly, Stemmler teaches and one of ordinary skill the art would understand that transport rolls 88 are part of the "processor portion" of the printing machine and are not in the duplex path of the inverter 40.

Stemmler's paper tray 83 (shown in figure 8 and reproduced below) uses a paper path defined between the labeled "feed rollers" and the transport rolls 88. Thus the paper is not inputted to the duplex path of the inverter 40 but rather by-passes the inverter 40 and inputs paper into the "processor portion" at rolls 88. Therefore, paper tray 83 does not input paper into a duplex paper path and fails to teach the limitations of claim 1.

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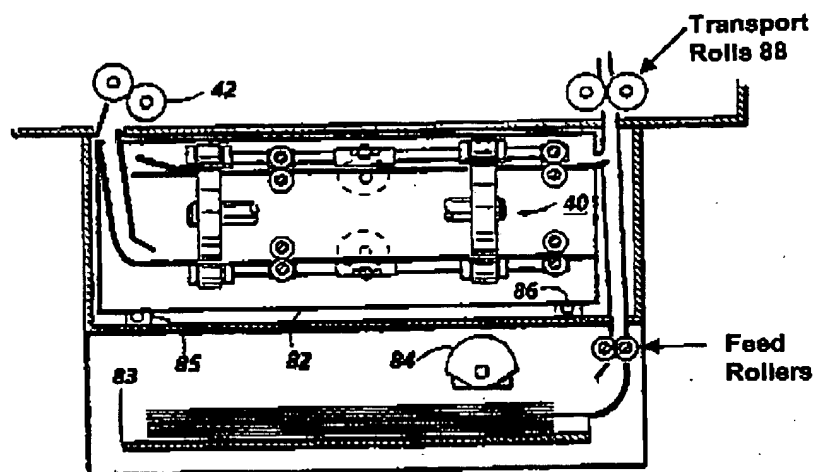


FIG. 8

Figure 8 from the Stemmle Patent

For these reasons, Stemmle fails to teach a media feeder configured to input print media into the duplex media path of the image forming device as recited in claim 1. Therefore, claim 1 is not anticipated by Stemmle, Stemmle fails to support the rejection, and the rejection should be reversed. Claim 1 thus patentably distinguishes over the reference and should be allowed. Accordingly, dependent claims 2-9 also patentably distinguish over Stemmle and are in condition for allowance.

Independent Claim 10

Claim 10 was rejected under 35 U.S.C. §102(b) as being anticipated by Stemmle.

Claim 10 recites "a media input unit configured for attachment to one side of the image forming device to input non-imaged media into the return media path of the image forming device." The return media path of Stemmle is formed by the duplex path side

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shifting inverter 40. For the rejection of claim 10, the Office Action on page 4 relies on the same paper tray 83 of Stemmler as cited under claim 1

As explained above, paper tray 83 inputs paper into rollers 88, which are downstream from the duplex path formed by the inverter 40. Rather, rollers 88 are part of the "processing portion" of the printing machine and thus paper tray 83 inputs paper to the "processing portion" and not the return path of the inverter 40. As such, paper tray 83 fails to meet the claimed limitation of a media input unit to input non-imaged media into the return media path. Accordingly, claim 10 is not anticipated by Stemmler and the rejection cannot stand.

Furthermore, claim 10 recites "where the media input unit is positioned where the return media path does not return the imaged media across the media input unit during duplex printing." As seen in Stemmler figure 8, the inverter 40 forms the duplex path that travels across the paper tray 83. Thus, this claimed limitation is not anticipated and the rejection cannot stand for this additional reason.

For these reasons, claim 10 is not anticipated and Stemmler fails to support a proper §102 rejection. The rejection should be reversed. Claim 10 thus patentably distinguishes over Stemmler and is in condition for allowance. Accordingly, dependent claims 11 – 15 also patentably distinguish over the reference and are in condition for allowance.

Independent Claim 16

Claim 16 was rejected under 35 U.S.C. §102(b) as being anticipated by Stemmler.

Claim 16 recites an image forming apparatus comprising a media storage unit, a primary media path, and a duplex media path where the duplex media path is configured to receive non-imaged print media from the media storage unit and to input the non-imaged print media to the primary media path for imaging.

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The Office Action on page 6 cites Stemmler figure 8 and paper tray 83 as teaching the claimed media storage unit. However as previously explained, paper tray 83 does not input media into the duplex path of the inverter 40. Rather, media is inputted downstream of the duplex path into rollers 88. As taught by Stemmler, rollers 88 are part of the "processing portion" of the printing machine, which Stemmler distinguishes from the duplex path of the inverter 40 (Stemmler, column 7, lines 23-27). Thus, the duplex path of Stemmler fails to anticipate the claimed duplex media path configured to receive non-imaged print media from the media storage unit.

Therefore, Stemmler fails to teach each and every limitation of claim 16 and fails to establish a proper §102 rejection. The rejection should be withdrawn and claim 16 should be allowed. Accordingly, dependent claims 17 – 21 also patentably distinguish over the reference and are in condition for allowance.

II. Whether Claim 21 is unpatentable under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,042,791 (Stemmler) or in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5,042,791 (Stemmler) in view of U.S. Patent No. 5,724,642 (Cala).

Claim 21 depends from independent claim 16. Since Stemmler fails to teach a duplex path configured to receive non-imaged print media from the media storage unit, it fails to teach the claimed logic to determine whether print media is inputted in the duplex media path as recited in claim 21. Thus, Stemmler fails to anticipate claim 21 and the rejection cannot stand.

As for the obviousness rejection, Cala fails to teach or suggest a duplex path as claimed and the Office Action does not use Cala for this purpose. Cala describes various logic components but fails to teach or suggest logic that is configured to determine whether print media is inputted in the duplex media path. This is because non-imaged print media is

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not inputted into the duplex path of Cala. Since neither Stemmler nor Cala teach or suggest the claimed duplex path, no teaching or suggestion is present for a logic that can be configured to perform a function for this non-existent feature. Thus, Cala fails to cure the shortcomings of Stemmler and the combination fails to establish a prima facie obviousness rejection. The rejection should be reversed and claim 21 should now be allowed.

III. Whether Claims 9, 13 and 20 are unpatentable under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,042,791 (Stemmler) as applied to claims 6, 10 and 16, and further in view of U.S. Patent No. 6,308,948 (Azumi).

Claim 9 depends from claim 6, which depends from independent claim 1. Claim 13 depends from independent claim 10 and claim 20 depends from independent claim 16. Since Stemmler fails to teach or suggest the respective independent claims of claims 9, 13, and 20 as described above, the combined references fail to establish a prima facie obviousness rejection. The rejection thus cannot stand and should be withdrawn. These claims should now be allowed.

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Conclusion

For the reasons set forth above, a prima facie obviousness rejection has not been established for any claim. Thus, all rejections are improper and should be reversed. Accordingly, claims 1-21 patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

DEC. 11, 2006
Date


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Claims Appendix

1. A media handling system for an image forming device configured with a primary media path and a duplex media path, the media handling system comprising:
a media feeder positioned adjacent to one side of the image forming device and configured to input print media into the duplex media path of the image forming device, and the media feeder being positioned to not be part of the duplex media path.
2. The media handling system as set forth in claim 1 wherein the duplex media path is a substantially horizontal media path.
3. The media handling system as set forth in claim 1 wherein the media feeder is configured to automatically input non-imaged media into the duplex media path of the image forming device.
4. The media handling system as set forth in claim 1 wherein the media feeder includes a high-capacity media storage unit to store a quantity of media.
5. The media handling system as set forth in claim 1 wherein the media feeder is configured to be detachably mounted to the one side of the image forming device.
6. The media handling system as set forth in claim 1 further comprising a media output unit configured to be positioned adjacent to the one side of the image forming device to receive media discharged from the image forming device.
7. The media handling system as set forth in claim 6 wherein the media feeder and the media output unit are configured to be vertically-stacked to reduce a footprint of the image forming device.

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8. The media handling system as set forth in claim 6 wherein the media feeder and the media output unit are integral within a housing.
9. The media handling system as set forth in claim 6 wherein the media output unit includes a media finishing device.
10. A media handling apparatus for inputting non-imaged media into an image forming device having a primary media path along which an image is formed on a print media, the handling apparatus comprising:
 - a return media path configured to selectively receive imaged print media from the primary media path and return the imaged media to the primary media path for multiple imaging;
 - a media input unit configured for attachment to one side of the image forming device to input non-imaged media into the return media path of the image forming device, where the media input unit is positioned where the return media path does not return the imaged media across the media input unit during duplex printing; and
 - a media output unit for receiving imaged media discharged from the primary media path, the media output unit being configured for attachment to the one side of the image forming device and stacked above the media input unit.
11. The media handling apparatus as set forth in claim 10 wherein the return media path is a substantially horizontal path.
12. The media handling apparatus as set forth in claim 10 wherein the media input unit further comprises a media storage unit to store a quantity of non-imaged media.
13. The media handling apparatus as set forth in claim 10 wherein the media output unit includes a media finishing device.

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14. The media handling apparatus as set forth in claim 10 wherein the media input unit is configured to be detachably mounted to the one side of the image forming device.
15. The media handling apparatus as set forth in claim 10 wherein the media input unit and the media output unit are integral within a common housing.
16. An image forming apparatus comprising:
 - a housing having at least one wall;
 - an image forming unit provided within the housing for forming an image onto print media;
 - a media storage unit configured to store a supply of non-imaged print media;
 - a primary media path for carrying print media to the image forming unit for imaging;
 - a duplex media path configured to receive imaged print media from the primary media path and return the imaged print media to the primary media path for duplex imaging where the returned imaged media is not returned to the media storage unit during the duplex imaging; and
 - the duplex media path being configured to receive non-imaged print media from the media storage unit and to input the non-imaged print media to the primary media path for imaging.
17. The image forming apparatus as set forth in claim 16 further comprising a media output unit positioned to receive imaged print media discharged from the primary media path where the media storage unit and the media output unit are stacked to reduce a footprint of the image forming apparatus.
18. The image forming apparatus as set forth in claim 16 further including a media feeder to feed the non-imaged print media from the media storage unit to the duplex media path.
19. The image forming apparatus as set forth in claim 17 wherein the media storage unit and the media output unit are contained within a common housing.

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20. The image forming apparatus as set forth in claim 16 wherein the media output unit includes a media finishing unit.

21. The image forming apparatus as set forth in claim 16 further comprising logic to determine whether print media is inputted into the primary media path or the duplex media path.

22. - 31. (Canceled).

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Evidence Appendix

None. There is no extrinsic evidence.

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Related Proceedings Appendix

None. There are no related proceedings.